

II. REMARKS

A. Introduction

In this Office Action claims 1-3, 6-8, 16, 21 and 23-38 are noted as pending and are rejected.

In summary of this Response, the written description is amended to a minor extent, claims 1, 6, 16, 24, 27, 30, 33 and 36 are amended, new claims 39-50 are added, and remarks are provided.

B. New Claims 39-44

These new claims are generally based on claims 1-3 and 16-18, and also recite that the recess is formed in an upper surface of the chassis.

For support see, e.g., Figs 11 and 12, and numbered paragraph [0054] of the application as filed.

C. New Claims 45-50

These new claims are generally based on claims 1-3 and 16-18, and recite that “when one wheel is moved up, one side portion of the leaf spring is bent and, when both wheels are moved up, both side portions of the leaf spring are bent”.

Support for this amendment can be found at, e.g., Figs. 12A and 12B, and numbered paragraphs [0054] and [0055]. That is, Fig. 12A and the corresponding text describe a suspension that imparts a biasing force to a single wheel or both wheels depending upon whether a single front wheel is moved up (Fig. 12A) or if both wheels are moved up (Fig. 12B). See also the January 30, 2007 Office Action in the Reexamination of the parent patent [control no. 95/000,036] (the “Reexamination”), at pages 10-14.

D. Rejection Under 35 U.S.C. Section 103

Claims 1-3, 6, 7, 16, 21, 23-25, 27-31 and 33-37 are rejected as being made obvious by Minato and Balthazor (each already of record).

Minato is cited for teaching “the basic inventive concept” with the exception of the

chassis having a recess portion in which the biasing member or leaf spring is held.” Balthazor is cited for teaching a “projecting portion (48) that is held within a recessed portion (46) of the chassis (Fig. 4) such that the projecting portion is sandwiched between the recessed portion and the shaft (Fig. 2).” The Action concludes that it would have been obvious based on Balthazor to modify Minato to include a recess “in order to simply and inexpensively connect a leaf spring to a toy vehicle such that it can be easily removed from the assembly without the use of tools”, citing column 1, lines 9-47.

In response, it is respectfully submitted that the present invention, as recited by amended claims 1-3, 6, 7, 16, 21, 23-25, 27-31 and 33-37, was not made obvious by any one, or a combination of, the cited references.

Minato discloses a see-saw member 36 which is supported above an upper chassis 29 through loop like members 38a and 38b (see, e.g., Figs. 2, 3 and 4b of Minato). “The Merriam Webster’s Collegiate Dictionary, Tenth Edition defines a ‘recess’ as an ‘indentation of cleft’, therefore one with ordinary skill in the art would not interpret the loop-like members (8a, 38b) of Minato as a recess since they are not indentations or clefts.” See the January 30, 2007 Office Action in the Reexamination, page 3, lines 3-6. Clearly, Minato fails to disclose at least the “recess” recited in the rejected independent claims herein, and as acknowledged in the Action.

Further, these rejected claims now also generally recite that the leaf spring/biasing member is supported on top of the chassis, that the vertical shafts of the turning members extend from/protrude from the top of the chassis.

Balthazor discloses a toy vehicle body 12 having a bottom portion 24 and depending portions 26 which serve as the vehicle chassis. See, e.g., Col. 2, lines 6-18 and 60-61 and Col. 1, lines 28-40. The spring 34 extends downward from the chassis 24, 26 to abut at its ends against the axle 16 to apply downward pressure. See Col. 2, lines 29-40 and 61-65, Col. 3, lines 11-30, and Col. 1, lines 33-35.

Thus, Balthazor shows a spring that is arranged between an axle and a chassis, whereas the invention recited by these amended independent claims recites a leaf spring that is on the top of the chassis, and with vertical shafts of the turning members extending to the top of the chassis, wherein the leaf spring applies downward force on the vertical shafts of the turning members. Nowhere does Balthazor suggest, nor would it even seem possible, to arrange the leaf spring on the top of the chassis, i.e., on top of the bottom portion 24 and depending portions 26. Even if one were to attempt to do so, there is no reasonable expectation that same would work, or that the arrangement would be simpler than Minato, or that it would be less expensive than the Minato arrangement. Also, since Balthazor relates to a solid or one piece elongated

axle extending between both wheels, it is not seen how such an axle could guide one of ordinary skill as to how to improve upon biasing spaced turning members, such as Minato's. For example, how would the notch 42 and projecting tab engage a turning member, where on the turning member, what would ensure a reliable engagement without impeding the operation of the turning member, etc. None of these questions are answered in the Action.

Nevertheless, when the art teaches that the spring is under the chassis, and an effort is made to combine same with Minato, Minato "would no longer resemble or function as a 'see-saw' structure... thus destroying Minato's invention." January 30, 2007 Office Action in the Reexamination, page 5, lines 11-14.

Finally, the alleged motivation to combine Balthazor and Minato is simplicity and inexpensiveness. These are the motivations for developing all inventions. Certainly more is needed for motivation to improve upon the biasing arrangement of the Minato turning members than this ubiquitous goal. That is, Balthazor must motivate one of ordinary skill how and why to improve upon the spring biasing of the turning members of Minato in a simple and inexpensive way, and yet all that Balthazor does is teach extending a spring with dependencies from the underside of a toy undercarriage to support a conventional one piece elongated axle. In light the questions posed above, it is not believed that Balthazor's use in Minato, would satisfy this alleged motivation. Thus, it is respectfully submitted that the motivation to modify Minato to arrive at the presently claimed invention is lacking in Balthazor, regardless of the ever-present need to simplify and economize.

E. Rejection of Claims 8, 26, 32 and 38 Under 35 U.S.C. § 103

These claims are rejected as being made obvious by the above combination and further in view of Perryman, also already of record.

The above comments regarding the inability of the underlying combination's failure to disclose or teach the invention recited by the claims from which these rejected claims depend, are expressly incorporated herein.

F. New Claims Relative to the Cited Art

As noted, claims 39-44 recite at least that the recess is formed in the upper surface of the chassis. The loop like members 38a and 38b of Minato are not in the upper surface of the upper chassis, as required by these claims, but rather are on the upper surface. See Office Action in the Reexamination, page 3, lines 6-8. Further, the alleged recess 46 of Balthazor is

formed on the underside of the chassis 24, 26. Accordingly, neither reference, nor the combination teaches or discloses the recited recess formed in an upper surface of the chassis.

New claims 45-50, on the other hand, recited at least the feature of each end of the leaf spring moving individually. Minato does not relate to individual ends moving. See, e.g., the January 30, 2007 Office Action in the Reexamination, page 13, first full paragraph. As Balthazor appears to relate to a solid horizontal axle, as opposed to independent vertical turning members, it is not seen how Balthazor could teach the leaf spring having ends which can bias individually.

G. Information Disclosure Statement ("IDS") Filed September 29, 2003

The Action indicates that "no copies of the cited foreign patent documents [filed with the IDS on September 29, 2003] were found in the parent application (10/056,110)".

To clarify, the IDS filed on September 29, 2003 cited the four Great Britain reference numbers 990,585; 1,072,412; 1,095,490; and 1,443,901, and one German reference number 2,002,252. However, the March 20, 2006 Office Action acknowledges Great Britain reference number 1,095,490. Nevertheless, it is believed that the Examiner's reference to "no copies of the cited foreign patent documents were found in the parent application" must refer to the above remaining three British and one German references.

All four of these British references were filed, along with a U.S. reference, by way of an IDS filed October 17, 2002 in the parent Serial No. 10/056,110 (the "'110 application"). A copy of the IDS and date-stamped postcard showing submission of these references is attached as Exhibit A for convenience of the Examiner as it does not appear that the '110 application has an electronic file wrapper.

In a July 3, 2003 Office Action in the '110 application, the Examiner initialed each of these five references as having been received and considered. A copy of this Office Action is attached as Exhibit B. Clearly, copies of the references were in the '110 file at the time of mailing of the Office Action. In addition, in this Office Action the Examiner cited "British" reference number 2,002,252.

Since the Examiner's characterization of reference number 2,002,252 as being "British" was not correct, Applicant's Response dated August 1, 2003 brought to the Examiner's attention that the reference is actually German and requested that the PTO records be corrected. A copy of this Response is attached as Exhibit C. Clearly, at the time of citation of this reference number 2,002,252, a copy had to be in the file of the '110 application.

In a September 8, 2003 Supplemental Notice of Allowability, the Examiner corrected reference number 2002252 to reflect that it was a German reference. A copy of this paper is

attached as Exhibit E.

Finally, attached is a copy of the front page of the U.S. Patent No. 6,656,011, which resulted from the '110 application. The four subject British references and the corrected German reference are all cited: it is correctly noted that the German reference was cited by the Examiner and the remaining references were cited by Applicant, consistent with above.

In light of the above, all of the subject foreign references were in the file for the '011 application. It is not understood how these references could now be missing from the file, or why it is Applicant's duty to prove they were appropriately filed and considered in the '011 application. In the latter regard, 37 C.F.R. Section 1.198(d) indicates that, where an IDS is filed in a continuation application, and the IDS references the parent (see the September 29, 2003 IDS, sections 6), no copies of the references cited in the IDS need be submitted in the continuation. Instead, it is the continuation Examiner's duty to review the references in the parent. MPEP Section 609.02.

Nevertheless, included as Exhibit F are copies of all five foreign references discussed above. It is expressly requested that the Examiner make these references of record in this continuation application by way of a PTO Form 892 with the next Action.

H. Information Disclosure Statement

Attached is another Statement which cites a reference cited in the co-pending reexamination Control No. 95/000,036 for the parent patent No. 6,656,011.

III. CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that claims 1-3, 6-8, 16 and 21-50 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 4/27/07

By: 

William F. Herbert
Registration No. 31,024

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501